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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/086,181 | 02/26/2002 | Ruth Gimeno | MNI-220 | 8227 |

7590 11/29/2004

Intellectual Property Group
MILLENNIUM PHARMACEUTICALS INC
75 Sidney Street
Cambridge, MA 02139

EXAMINER

WILDER, CYNTHIA B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1637

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,181

Applicant(s)

GIMENO ET AL.

Examiner

Shar Hashemi

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 13-20, drawn to a method of identifying a nucleic acid molecule, classified in class 536, subclass 22.1.
 - II. Claims 10-12, 21-23, drawn to a method of identifying a polypeptide, classified in 530, subclass 350.
 - III. Claims 24 & 25, drawn to a method of screening for nucleic acid molecules capable of treating aberrant lipogenesis, classified in 435, subclass 6.
 - IV. Claims 24, 26, 53, & 63-68, drawn to a method of screening for nucleic acid molecules capable of treating aberrant lipolysis, classified in 435, subclass 6.
 - V. Claims 24 & 27, drawn to a method of screening for nucleic acid molecules capable of treating obesity, classified in 435, subclass 6.
 - VI. Claims 24 & 28, drawn to a method of screening for nucleic acid molecules capable of treating diabetes, classified in 435, subclass 6.
 - VII. Claims 24, 25, & 29-62, drawn to a method of screening for polypeptides capable of treating aberrant lipogenesis, classified in 435, subclass 6.
 - VIII. Claims 24, 26, 29-31, 33, & 36-49, drawn to a method of screening for polypeptides capable of treating aberrant lipolysis, classified in 435, subclass 6.
 - IX. Claims 24, 27, 29-31, 34, & 36-49, drawn to a method of screening for polypeptides capable of treating obesity, classified in 435, subclass 6.

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- X. Claims 24, 28, 29-31, 35, 36-49 & 69, drawn to a method of screening for polypeptides capable of treating diabetes, classified in 435, subclass 6.
- XI. Claims 70-72, drawn to a method of screening for a compound using a transgenic mouse, classified in class 800, subclass 295.

2. The inventions are distinct, each from the other because of the following reasons:

Restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I-XI are directed to methods that are distinct both physically and functionally, and are not required one for the other. Invention I requires the search of methods of identifying a nucleic acid molecule, which is not required by any of the other groups. Invention II requires the search of methods of identifying a polypeptide, which is not required by any of the other groups. Invention III requires the search of methods of screening for nucleic acid molecules capable of treating aberrant lipogenesis, which is not required by any of the other groups. Invention IV requires the search of methods of method of screening for nucleic acid molecules capable of treating aberrant lipolysis, which is not required by any of the other groups. Invention V requires the search of methods of screening for nucleic acid molecules capable of treating obesity, which is not required by any of the other groups. Invention VI requires the search of methods of screening for nucleic acid molecules capable of treating diabetes, which is not required by any of the other groups. Invention VII requires the search of methods of screening for polypeptides capable of treating aberrant lipogenesis, which is not required by any of the other groups. Invention VIII requires the search of methods of screening for polypeptides capable of treating aberrant lipolysis, which is not required by any of the other groups. Invention IX requires the search of methods of screening for polypeptides capable of treating obesity, which is not required by any of the other groups. Invention X

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requires the search of methods of screening for polypeptides capable of treating diabetes, which is not required by any of the other groups. Invention XI requires the methods of screening for a compound using a transgenic mouse. Therefore, a search and examination of all eleven methods in one patent application would result in an undue burden, since the searches for the eleven methods are not co-extensive, the classification is different, and the subject matter is divergent.

Because these inventions are distinct for the reasons given above and the search required for each group is not required for the other groups, restriction for examination purposes as indicated is proper.

CONCLUSION

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shar Hashemi whose telephone number is (703) 305-4840 and whose e-mail address is shar.hashemi@uspto.gov. However, the Office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can be best reached on weekdays from 7:00 a.m. to 3:30 p.m. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature, matching or filed papers or relating to the status of this application or proceeding should be directed to the Tracey Johnson for Art Unit 1637 whose telephone number is (703) 305-2982.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-1235 and Before Final FAX (703) 872-9306 or After Final FAX (703) 308-9307.

February 23, 2003

**GARY BENZION, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**

A handwritten signature in black ink, appearing to read "Gary Benzion", written in a cursive style.A handwritten signature in black ink, appearing to read "Gary Benzion", written in a cursive style.